



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,350	03/16/2004	Mark S. Nichols	7522-8	2106

30448 7590 03/08/2006

AKERMAN SENTERFITT
P.O. BOX 3188
WEST PALM BEACH, FL 33402-3188

EXAMINER

ROWAN, KURT C

ART UNIT	PAPER NUMBER
----------	--------------

3643

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/801,350	Applicant(s) NICHOLS, MARK S.	
	Examiner Kurt Rowan	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 15, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-29 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 6, 2005 has been entered.

Election/Restrictions

2. Claims 31-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the shank receiving cavity.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10, 11, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle, Jr. (US 2002/0078619) in view of Pippert (US 5,070,639) and McClellan (US 5,220,743).

The patents to Hurtle, Pippert, and McClellan show fishing lures. Hurtle shows a body 14, 15 having at least one cavity 18 in a midsection of the body and at least one opening 32 in a top surface of the body. Hurtle shows a hook 20 having a weight 24 coupled to the hook along a shank 28 of the hook such that the hook is positioned closer to the line receiving portion 22 of the hook wherein the hook is positioned in the at least one cavity such that at least a portion of the weight contacts inner surfaces of the cavity thereby resisting the hook from being pulled from the body when the hook is pulled. Hurtle shows a shank receiving cavity (not labeled) where the shank passes through the front of the body as shown in Fig. 1. The shank receiving cavity extends from the cavity containing the weight 24 and the nose of the body at eye hole 23. The patent to Pippert shows a weighted lure having a body 24 with a cavity 38 with an inner wall in the midsection of the body having a portion 30 that is generally orthogonal to the shank containing region that prevents the weight from being pulled through the shank containing region. The patent to McClellan shows a fishing lure having a weight 35 mounted on a fishing hook closer to the throat of the hook than the line receiving portion 28 of the hook. In reference to claim 1, it would have been obvious to provide Hurtle with an inner wall in the midsection of the body as shown by Pippert having a portion 30 that is generally orthogonal to the shank containing region for the purpose of retaining the weight from being pulled through the shank containing region. The combination of

Hurtle as modified by Pippert, and McClellan does not show the midpoint of the weight positioned at a mid-section of the body, but it would have been obvious to position the midpoint of the weight at a mid-section of the body to change the action of the lure in the water and since the change in location of parts is obvious. See *In re Japikse*, 86 USPQ 70. The patent to Pippert shows a fishing lure having a body saving device 16 coupled to the base 14. In reference to claim 3, McClellan shows at least a portion of the weight 35 coupled to a bend 30 in the hook as shown in Fig. 6. In reference to claim 4, McClellan shows the weight further comprising a base 41. In reference to claim 5, the base 41 shown by McClellan extends the entire length of the weight. In reference to claim 6, it would have been obvious to provide the fishing lure of Hurtle as modified by McClellan with a body saving device as shown by Pippert to retain the soft plastic fishing lure to the body. In reference to claims 8 and 9, Pippert shows one protrusion 16, but it would have been obvious to have more than one such as two with one on each side of the weight for multiplied effect. It would have been further obvious to employ at least two protrusions on each side of the weight for the same reasons stated above. See *In re Harza* 124 USPQ 378. In reference to claim 10, McClellan discloses lead 19 in column 3, line 40. In reference to claim 11, Hurtle discloses a weight with a base aligned generally with the shank of the hook that extends wider than a width of the hook. In reference to claim 14, Hurtle shows at least one cavity including a weight containing region and a shank containing region extending from the weight containing region toward a nose of the body and sized to allow a shank of the hook to be inserted into the shank containing region but to restrict the weight from being inserted into the shank

Art Unit: 3643

containing region. In reference to claim 15, Hurtle shows an eye 22 protruding from or through a leading surface of the body

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle in view of Pippert, and McClellan as applied to claim 1 above, and further in view of Huppert.

The patents to Hurtle, Jr., Pippert, and McClellan show fishing lures as discussed above, but do not show a plurality of ribs extending around the body. The patent to Huppert shows a fishing lure having a plurality of ribs 61 extending around the body in Fig. 5. In reference to claim 13, it would have been obvious to provide the lure of Hurtle as modified by Pippert, and McClellan with a plurality of ribs as shown by Huppert to resemble a target species.

4. Claims 12, 17-22, 23-26, 27, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle, Jr. in view of Pippert, and McClellan as applied to claim 1 above, and further in view of Admitted Prior Art.

The patents to Hurtle, Pippert, and McClellan show fishing lures and have been discussed above. This combination shows a head and a tail, but not a plurality of legs extending from the head which is shown in Figs. 1-2 of the instant application as "Prior Art". In reference to claims 12, 17, it would have been obvious to provide the lure of Hurtle as modified by Pippert, and McClellan with a plurality of legs as shown by the Admitted Prior Art of Figs. 1-2 for the purpose of making the lure resemble a shrimp which is a desired prey species. In reference to claim 18, Hurtle shows the bottom

aspects of the weight are substantially enclosed by the body. In reference to claim 19, Hurtle shows an opening 32 in a top surface of the body in communication with the at least one cavity 18 as shown in Fig. 1. In reference to claim 20, McClellan shows the weight 35 in communication or coupled with a bend 30 of the hook as shown in Fig. 6. In reference to claim 21, McClellan shows a base 41 coupled to the weight 35. In reference to claim 22, McClellan shows the base extending the entire width of the weight and the base has a width equal to the other portions of the weight, but it would have been obvious to employ a base having a wider width to increase the stability of the lure noting that changes in shape are obvious. See *In re Dailey et al.*, 149 USPQ 47. In reference to claim 23, Pippert shows a body saving device 16, 30 as shown to retain the soft plastic lure on the body as disclosed by Pippert in column 4, line 21. In reference to claim 24, Pippert shows the body saving device as a protrusion 16 extending from an outer surface of the base proximate to an edge of the weight positioned proximate to a bottom edge of the body. In reference to claim 27, McClellan discloses a lead weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a long, sweeping horizontal stroke extending to the right.

Kurt Rowan
Primary Examiner
Art Unit 3643

KR